

**REMARKS**

This is in response to the Office Action of March 9, 2007. Claims 2 and 14 are amended based upon disclosure in lines 18-22 on page 24 of the specification (emphasis supplied):

Besides, the component (G) may be ***premixed with water to hydrolyze a part or all of the hydrolyzable groups into silanol groups*** to improve the dispersibility, and a homogeneous aqueous solution thus formed is used to make the composition. To facilitate the homogenization, the hydrolysis may be promoted by raising a temperature or by adjusting a pH of an aqueous phase to the range of from 2 to 4 with a little amount of acid. An excessively low pH may promote condensation of the hydrolyzed products to have an adverse effect.

Claim 9 is amended to depend from and be consistent with claim 2. No new matter is introduced by this Amendment. Claims 2-4 and 9-16 remain pending in the application.

Claim 9 was rejected under the second paragraph of 35 U.S.C. § 112 as failing to define the invention properly. Office Action, page 2. Claim 9 is amended to depend on claim 2. The terminology "at least two hydrolyzable groups" is deleted. Claim 9 as amended is now consistent with claim 2, indicating that the hydrolyzable group which has not been hydrolyzed may be an alkoxy group, an acyloxy group, or an oxime group.

Claims 2-4 and 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 24 49 085 to Hoeckemeyer et al. ("Hoeckemeyer"). Office

Claims 2-4 and 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 24 49 085 to Hoeckemeyer et al. ("Hoeckemeyer"). Office Action, pages 2-3. The rejection is respectfully traversed.

The Examiner argues that a skilled artisan might incorporate the epoxysilane described in Hoeckemeyer as a crosslinking agent which might undergo hydrolysis during the storage. However, as admitted by the Examiner, a content of the silanol formed by such unintentional hydrolysis is very small. It is too small to attain the relevant effect of the present invention – that is, improved oil repellency by insolubilization of PVA.

This theoretical negligibly small amount of a substance cannot negate the unobviousness of a composition comprising a substantial amount of the substance, particularly where the substantial amount of the substance is what permits the composition to attain a desired beneficial effect.

Furthermore, Hoeckemeyer does not teach or suggest how to produce a large enough amount of silanol or a condensate thereof to improve oil repellency. Applicants have discovered that mixing the silane with water prior to the other components improves oil repellency of a coating. Mixing all the components simultaneously cannot attain the improvement. Nothing in the Hoeckemeyer disclosure suggests this newly discovered method of providing Applicants' beneficial improvement in technology.

The Examiner argues on page 4 of the Office Action that it would have been obvious to combine a composition within the breadth of the reference disclosure having a SiH crosslinking agent with another composition having a

condensed methytrimethoxysilane crosslinking agent. Applicants respectfully submit that, in order to properly reject the claims herein, there must be a reason to make this combination – a person of ordinary skill in the art must expect some advantageous result from the combination in order for the combination to be “obvious.” The Examiner has not met the burden of providing this reason.

The recent decision of the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ 1385 (U.S. 2007) supports Applicants’ position in this regard. The holding of the Court makes it clear that simply showing that all of the elements of the application/patent claim are present in the prior art does not necessarily mean that an invention is obvious. The Court states that “... a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” and that “This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” Part of the obviousness inquiry here must be a consideration of whether there is a reason for the person of ordinary skill in the art to do what is claimed. Accordingly, in general it is important to identify a **reason** that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way they are combined in a claimed new invention.

Nothing in the Hoeckemeyer disclosure teaches or suggests a composition that contains “a silane (G) containing a hydrolyzable group, at least part of the

silane (G) having been converted to silanol by hydrolyzing the hydrolyzable group and/or a condensate of the silanol by mixing the silane (G) with water (E) prior to adding the silane (G) to other components.”

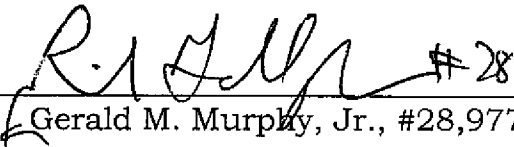
For the various reasons discussed above, the present invention is unobvious over the Hoeckemeyer disclosure. Withdrawal of the rejection of claims 2-4 and 9-13 in their current form is earnestly solicited.

Claims 14-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hoeckemeyer. Office Action, page 2. Like independent claim 2, independent claim 14 has been amended to require “a silane (G) containing a hydrolyzable group, at least part of the silane (G) having been converted to silanol by hydrolyzing the hydrolyzable group and/or a condensate of the silanol by mixing the silane (G) with water (E) prior to adding the silane (G) to other components.” Claim 14 is novel and unobvious over the cited reference DE 2449085 for the reasons stated above.

It is respectfully submitted that, for the reasons given hereinabove, the application as amended herein is in condition for allowance.

The Examiner is invited to contact Richard Gallagher (Reg. No. 28,781) at  
(703) 205-8008 with any questions pertaining to this application.

Respectfully submitted,  
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #28,781  
Gerald M. Murphy, Jr., #28,977

GMM/RG  
4710-0106P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000